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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,252	10/20/2003	Jeffrey S. Malkin	19504-008001	3426

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EXAMINER
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MANOHARAN, MUTHUSWAMY GANAPATHY

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/690,252

Applicant(s)

MALKIN ET AL.

Examiner

Muthuswamy G. Manoharan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments with respect to claims on 9/12/2006 have been considered but are moot in view of the new ground(s) of rejection.

Applicant mentioned that support for amendments, such as, "receive instructions that a particular library has been selected" can be found in Specification (Paragraphs [0027] and [0033]; Figure 3,315 and 320). However, it is not clear (from the above paragraphs) where in the specification (Paragraphs [0027] and [0033]) applicant teaches the limitation "receive instructions that a particular library has been selected".

Applicant's arguments are related to the amended claims and therefore, applicant is advised to refer to the Office action for further explanation.

### *Claim Rejections - 35 USC § 112*

Claims 1, 5 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, "**receive instructions that a particular library has been selected**", which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1,5 and 9 Applicant recites, "store **a library** of two or more different sound segments, receive instructions that **a particular library** has been selected". Since there is only a **single library and no other library to chose from**, it is not clear what kind of selection has to be performed. This renders the claim vague and indefinite.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-12 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollstrom in view of Hoisko et al. (hereinafter Hoisko) (U.S. 2002/0082007) and further in view of Kovales et al. (US 7003083).**

Regarding claim 1, Hollstrom discloses a device for inserting sound segments into a voice channel carrying a voice stream of a voice transmission communication device (item 27 in Figure 3; Paragraph [0046], line 5), comprising:

a communications interface configured to establish a voice channel ("mobile telephone", Abstract);

a mixer (item 30, Figure 3; Paragraph [0046], line 3) configured to couple with the audio channel (item 29 in Figure 3, Paragraph [0046], line 6), to receive a selected sound segment in response to a trigger activation and to inject the selected sound segment into the voice channel, the voice channel contemporaneously carrying the selected sound segment and voice stream as a single output stream (Paragraph [0013], lines 1-10).

Hollstrom did not teach expressly a client controller structured and arranged to:

Store a library of two or more sound segments,

Receive instructions that a particular library has been selected, and

Load the library such that multiple sound trigger buttons on a handset become programmed to each correspond to a specific sound segment within the selected library;

a display configured to present a menu associated with two or more different sound segments within the selected library loaded by the client controller;

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two or more sound trigger buttons adapted to be activated in response to a user input (Paragraph [0017], lines 5-11), each sound trigger button being configured to enable a selection of specific corresponding sound segments within the library loaded by the client controller for insertion into the voice channel responsive to sound trigger button activation during an ongoing communication over the voice channel (Paragraph [0017], lines 5-11).

However, Hoisko teaches in an analogous art, a client controller structured and arranged to:

Store a library (20a, 20b, ....20n) of two or more sound segments (10a, 10b, ... 10n) (For each effective state (could represent a library) in the menu directory may also contain several musical compositions; several musical compositions are associated with the selected effective state; Paragraph [0019]),

Receive instructions that a particular library has been selected ("the user of the phone selects in the menu effective state"; Note: **For each effective state there corresponds a particular library with set of musical compositions**, Paragraph 0017), and

Load the library ("**right musical combination is fetched from the directory**", Paragraph [0027]) such that multiple sound trigger buttons on a handset become programmed to each correspond to a specific sound segment within the selected library ("a cellular phone may be programmed to include a function ... by pressing a key on the phone", Paragraph [0025], lines 10-13) to each correspond to a specific sound segment within the selected library (Paragraph [0027]);

a display ("display", Paragraph [0017]) configured to present a menu associated with two or more different sound segments within the selected library loaded by the client controller (browse the menu using the phone's keypad", Paragraph [0017]);

a communications interface configured to establish a voice channel ("cellular phone", Abstract; item 33 in Figure 1)

a mixer configured to couple with audio channel, to receive a selected sound segment within the library loaded by the client controller in response activation of the sound trigger button and to inject the selected sound segment into the voice channel, the voice channel contemporaneously carrying the selected sound segment and voice stream as a single output stream (**"The voice of the caller is transferred normally on an audio channel from the cellular phone of the caller to the phone of the called party, and simultaneously with the voice a musical composition describing the affective state of the caller is played on a device selected by the called party"**, Paragraph [0032]);

two or more sound trigger buttons adapted to be activated in response to a user input (Paragraph [0017], lines 5-11), each sound trigger button being configured to enable a selection of specific corresponding sound segments within the library loaded by the client controller for insertion into the voice channel responsive to sound trigger button activation during an ongoing communication over the voice channel (Paragraph [0017], lines 5-11; Paragraph [0018-0019]; user of the phone may select the effective state (requires a trigger button) and background music (requires another trigger button),

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Paragraph [0019], lines 26-27; "a cellular phone may be programmed so as to include a function ... by pressing a key on the phone", Paragraph [0025], lines 10-13).

Therefore, it would have been obvious to one of ordinary skill in the art to at the time of the invention to have a client controller structured and arranged to:

Store a library of two or more sound segments,

Receive instructions that a particular library has been selected, and

Load the library such that multiple sound trigger buttons on a handset become programmed;

a display configured to present a menu associated with two or more different sound segments within the selected library loaded by the client controller;

two or more sound trigger buttons adapted to be activated in response to a user input, each sound trigger button being configured to enable a selection of specific corresponding sound segments within the library loaded by the client controller for insertion into the voice channel responsive to sound trigger button activation during an ongoing communication over the voice channel. This modification improves the content and intelligibility of communication.

Neither Hollstrom nor Hoisko teaches trigger activation during an ongoing communication over the voice channel. However, Kovales teaches in an analogous art, trigger activation during an ongoing communication over the voice channel ("the mixing may occur within a telephone conversation", Abstract, lines 5-6). Therefore, it would be obvious to one of ordinary skill in the art, to have the trigger activation during an



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ongoing communication over the voice channel. This modification provides additional flexibility to the user as to when to activate the trigger.

Regarding claim 2, Hollstrom discloses the device of claim 1, further comprising a sound encoder (Paragraph [0046], lines 13) configured to receive the sound segment from a source external (Paragraph [0036], lines 4-5) to the device.

Regarding claim 3, Hollstrom discloses the device of claim 2, wherein the sound segment comprises a file format comprising one from a group consisting of an MP3 file format, a WAVE file format, and an audio video interleave tile format (Paragraph [0035], lines 1-3).

Regarding claim 4, Hollstrom discloses the device of claim 1, further comprising a communications device interface (Figure 1, item 8; paragraph [0031], lines 1-3) for coupling with a communication device (Figure 3, item 27, items 30, 31, 29).

Claims 5-8 are rejected for the same reason as set forth in claims 1-4 respectively.

Claims 9-12 are rejected for the same reason as set forth in claims 1-4 respectively.

Regarding claim 17, Hollstrom in view of Hoisko and further in view of Kovales teaches all the particulars of the claim 1. Hollstrom did not teach expressly wherein the two or more trigger buttons adapted to be activated in response to a user input. However, Hoisko teaches in an analogous art, wherein the two or more trigger buttons adapted to be activated in response to a user input (Paragraph [0017]). Therefore, it

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would be obvious to one of ordinary skill in the art at the time of invention to have the two or more trigger buttons adapted to be activated in response to a user input.

Neither Hollstrom nor Hoisko teaches two or more triggers adapted to be activated in response to a user input during a time period after a call initiating party and a call receiving party have begun conversation. However, Kovales teaches in an analogous art, two or more triggers adapted to be activated in response to a user input during a time period after a call initiating party and a call receiving party have begun conversation ("the mixing may occur within a telephone conversation", Abstract, lines 5-6). Therefore, it would be obvious to one of ordinary skill in the art, to have the two or more triggers adapted to be activated in response to a user input during a time period after a call initiating party and a call receiving party has begun conversation. This modification provides additional flexibility to the user as to when to activate the trigger.

Claims 18 and 19 are rejected for the same reasons as set forth in claim 17.

Regarding claim 20, Hollstorm in view of Hoisko teaches all the particulars of the claim 5. Neither Hollstorm nor Hoisko teaches the method wherein selecting, in response to the user input reflecting activation of the sound trigger button during the ongoing communication over the established voice channel includes selecting, in response to the user input reflecting activation of the sound trigger button during the ongoing communication after the voice channel is established. However, Kovales teaches in an analogous art, wherein selecting, in response to the user input reflecting activation of the sound trigger button during the ongoing communication over the

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established voice channel includes selecting, in response to the user input reflecting activation of the sound trigger button during the ongoing communication after the voice channel is established ("the mixing may occur within a telephone conversation", Abstract, lines 5-6). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method wherein selecting, in response to the user input reflecting activation of the sound trigger button during the ongoing communication over the established voice channel includes selecting, in response to the user input reflecting activation of the sound trigger button during the ongoing communication after the voice channel is established. This modification provides additional flexibility to the user as to when to activate the trigger.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muthuswamy G. Manoharan whose telephone number is 571-272-5515. The examiner can normally be reached on 7:30AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eng George can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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SUPERVISORY PATENT EXAMINER